

REMARKS/ARGUMENTS

The specification has been amended to provide more descriptive terminology, which provides explicit antecedent basis for the language in the claims as presently amended. Claim 1 has also been amended to include the limitations of claims 2 and 3, now cancelled.

Claim 1 stood rejected under 35 U.S.C. §103 as being unpatentable over Duckett U.S. 3,945,663. This rejection is rendered moot by the amendment of claim 1 to include the limitations of claims 2 and 3.

Claims 2-8 stood rejected under 35 U.S.C. §103 as being unpatentable over Duckett in view of Gladieux U.S. 4,240,654. To the extent that this combination would be applied against claims as presently amended, such rejection is traversed for the reasons following.

Duckett discloses a piston cylinder assembly including a piston rod guide fitted to a working cylinder, and a pair of envelope bodies in an equalizing space surrounded by an outer tube. Each of the envelope bodies is provided with a connecting element which is fixed in the outer tube. There is no suggestion that the connecting element be fitted to a bore in the rod guide. On the contrary, each connecting element is designed as a clamp having parts 24, 27 which are clamped to a side wall of the envelope body, the head 24 having a stem 26 which is received through a hole in the side wall. This construction is not suited to being received in a bore through the rod guide, because there is not sufficient radial clearance in the equalizing space. Thus, contrary to a statement made by the Examiner, the provision of a connecting element in the rod guide is not "an obvious alternative connection arrangement". The connecting element disclosed by Duckett renders such a modification impossible. The modification proposed by the Examiner would amount to impermissible hindsight based on applicant's disclosure.

It is noted that none of the prior art of record discloses a connecting element fitted to an enveloping body of a piston-cylinder arrangement, and received in a bore in the rod guide, much less a connecting element of the type claimed by applicant. This is an important element of applicant's invention, which is necessary to establish a *prima facie* case of obviousness.

Gladieux discloses a hose coupling having a socket 30 having an opening 36 provided with a groove 41 in which a snap ring 40 is received. This engages a shoulder 28 on a plug member 20 fitted to a hose end. The Examiner concludes that it would be obvious to fit this coupling to the envelope body disclosed by Duckett. However, there is no suggestion in Gladieux as to how the disclosed coupling would be fitted to anything but a hose. Gladieux is non-analogous art which would not be considered by person skilled in the art of piston-cylinder assemblies, as pertinent to the problem of sealing a gas-filled envelope with respect to a surrounding medium. The selection of this reference can only be based on hindsight gleaned from applicant's disclosure.

The CAFC has repeatedly held that one cannot use hindsight to pick and choose among isolated disclosure of the prior art to deprecate the claimed invention. In re Fritch, 5USPQ2d 1596 (Fed. Cir. 1988); In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998)

Thus, the Examiner has failed to established a *prima facie* case of obviousness for at least the following reasons: (1) an important element of the claimed invention, i.e., the connecting element received in the rod guide, is missing; (2) one skilled in the art would not look at hose couplings; and (3) there is no clue as to how the selected references would be combined.

The claims as amended being definite and patentable over the art of record, withdrawal of the rejections and early allowance are solicited.

It is believed that no other fees or charges are required at this time in connection with the present application; however, if any other fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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